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EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/577,533

Applicant(s)

NAGEL, ROBERT H.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/15/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-57 and 72-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-56, 72, 73, 75-77, 79-84 and 88-93 is/are rejected.
- 7) ☒ Claim(s) 57, 74, 78 and 85-87 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to Applicant's amendment, filed on 07/15/2004.
2. Claims 53-57 and 72-93 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **53-56, 72, 73, 75-77, 79-84 and 88-93** are rejected under 35 U.S.C. 103(a) as being unpatentable over Graunke et al. (U.S. Pat. No. 5,991,399) in view of Phillips (U.S. Pat. No. 5,873,604).

As per claims 53, and 72, 73, 75-77, 79-84 and 88-93, Graunke substantially discloses a secure distribution of a private key to a user's application program (which is readable as Applicant's claimed invention wherein it is stated that a method for providing counterfeit document), comprising:

providing a counterfeit resistant document recording medium, having thereon a predefined unique document identifier and at least one security feature (see., abstract, col 3, lines 5-20, lines 53-67, specifically wherein it is stated that a private key to a

user's application program such as DVD or CD-ROM with conditional access based on verification of the trusted player's integrity and authenticity, col 4, lines 8-61, asymmetric key pair, key compiler, private key);

defining a variable document content for imprinting on an identified recording medium (see., abstract, col 3, lines 53-67, col 4, lines 1-61, specifically wherein it is stated that movie, song, game, etc, as variable document for prevent an unencrypted copy or imprint of digital content to be made)

storing the variable document content in a database indexed by associated document identifier (see., abstract, col 3, lines 53-67, col 4, lines 1-61, specifically CD-ROM, DVD); and

authenticating the counterfeit resistant document by authenticating the security feature and comparing the stored document content with a perceived document content (see., abstract, 3, lines 53-67, col 4, lines 26-61). The digital signature is disclosed in col 4, lines 8-23, col 5, lines 15-40. It is to be noted that Graunke fails to explicitly disclose that defining variable document content comprising at least text and graphic images. However, Phillips discloses a document protection which employs a latent validation image and text (see., abstract, col 8, lines 54-67). It would have been obvious to a person of ordinary skill in the art at the time the invention was to modify the secure distribution of Graunke by including the limitations detailed above as taught by Phillips because such modification would validate and protect document against unauthorized duplicating or counterfeiting.

As per claim 54, Graunke discloses the claimed method, wherein said authenticating the security feature comprises execution of a cryptographic process (see., abstract, col 4, lines 15-61, col 7, lines 1-7).

As per claims 55, 56 and 58 Graunke discloses the claimed method of financially accounting for said stored and authenticating (see., col 7, lines 16-40, specifically wherein it is stated that the request may include some financial information such as credit card number or billing identifier, and the remote process is disclosed in col 3, lines 14-21, specifically wherein it is stated that the tamper resistant key module is then executed on the remote system to check the integrity and authenticity of the program or content, it is obvious to recognize that the remote process can operate asynchronous or delay from the local process or computer system since it is a common computer process).

As per claims 72, 81, 82, 83, 84, 85, 86, 87 Graunke substantially discloses a secure distribution of a private key to a user's application program (which is readable as Applicant's claimed invention wherein it is stated that a method of authenticating a document), comprising:

providing a document stock (see., abstract, col 3, lines 5-20, lines 53-67, specifically wherein it is stated that a private key to a user's application program such as DVD or CD-ROM with conditional access based on verification of the trusted player's integrity and authenticity, col 4, lines 8-61, asymmetric key pair, key compiler, private key);

preprinting the document with an essentially unique identifier or key (see., col 3, lines 5-20, please note that the encrypting predetermined data is readable as preprinting of a document or prerecording key into the content, and non-secure communications channel see., fig 2, item 34);

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defining a content for the document (see., abstract, col 3, lines 53-67, col 4, lines 1-61, specifically wherein it is stated that movie, song, game, etc, as variable document for prevent an unencrypted copy or imprint of digital content to be made);

generating an associated digital signature for verification of the document content and said essentially unique identifier (see., col 5, lines 15-43, col 7, lines 1-7);

printing or copy or download or record the content on the document stock by means of a computer printer (see., col 4, lines 24-61, specifically wherein it is stated that if the key module verifies that the storage device reader is authentic and that access to the digital content is allowed or may be recorded music etc, it is obvious to recognize that the computer method of Graunke fig 10 is capable of printing lithographed pattern since it is a common printing practice where only those areas to be printed will retain ink). The digital signature is disclosed in col 4, lines 8-23, col 5, lines 15-40. It is to be noted that Graunke fails to explicitly disclose that defining variable document content comprising at least text and graphic images. However, Phillips discloses a document protection which employs a latent validation image and text (see., abstract, col 8, lines 54-67). It would have been obvious to a person of ordinary skill in the art at the time the invention was to modify the secure distribution of Graunke by including the limitations detailed above as taught by Phillips because such modification would validate and protect document against unauthorized duplicating or counterfeiting.

As per claim 73, Graunke discloses the claimed method of printing the digital signature on the document stock by the computer printer (see., col 4, lines 24-61, col 5, lines 15-51).

As per claim 75, Graunke discloses the claimed method of authenticating the document by verifying that the digital signature corresponds to the document content and essentially unique identifier (see., col 5, lines 15-51).

As per claims 76, 77, Graunke discloses the claimed method wherein an anticounterfeit features comprise a set of visually distinct fibers in said document stock or encryption stock into the content (see., col 3, lines 53-67, col 4, lines 1-61, please note that anticounterfeit with a set of visually fibers document stock is readable as a set of encryption keys install into the content or document).

As per claims 79, 80, Graunke discloses the claimed method of accounting to a content proprietor for a printing of the document (see., col 7, lines 16-40, specifically wherein it is stated that the request may include some financial information or account such as credit card number or billing identifier).

AS per claims 88, 89, 90, 91 and 92 Graunke substantially discloses a secure distribution of a private key to a user's application program (which is readable as Applicant's claimed invention wherein it is stated that a an authenticatable recording), comprising:

a document stock having counterfeit or encryption resistant features (see., abstract, col 3, lines 5-20, lines 53-67, specifically wherein it is stated that a private key to a user's application program such as DVD or CD-ROM with conditional access based on verification of the trusted player's integrity and authenticity, col 4, lines 8-61, asymmetric key pair, key compiler, private key or digital signature);

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an imprinted tamper resistant unique identifier (or keys) on the document stock (see., col 3, lines 5-20, please note that the encrypting predetermined data is readable as preprinting of a document or prerecording key into the content and comparing the computed signature or keys against a predetermined value, and non-secure communications channel see., fig 2, item 34);

a content recording surface with a blank area suitable for printing (see., abstract, col 3, lines 53-67, col 4, lines 1-61, col 3, lines 53-67, DVD, CD-ROM, specifically wherein it is stated that movie, song, game, etc, as variable document for prevent an unencrypted copy or printing of digital content to be made).

It is to be noted that Graunke fails to explicitly disclose that defining variable document content comprising at least text and graphic images. However, Phillips discloses a document protection which employs a latent validation image and text (see., abstract, col 8, lines 54-67). It would have been obvious to a person of ordinary skill in the art at the time the invention was to modify the secure distribution of Graunke by including the limitations detailed above as taught by Phillips because such modification would validate and protect document against unauthorized duplicating or counterfeiting.

As per claim 93, Graunke discloses the claimed limitations wherein the imprinted tamper resistant unique identifier comprises a predictable portion and a random portion (see., col 5, lines 52-67, col 8, lines 61-67, please note that key module 18 of fig 1 has significant portions that are processed by the tamper resistant compiler, and each portion has a key, and therefore, it is obvious to realize that encryption and decryption keys are readable as a predictable portion key and a random portion key, also col 5, lines 52-67).

Allowable Subject Matter

5. Claims 57, 74, 78 and 85-87 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 07/15/2004 have been fully considered but they are not persuasive.

Applicant argues that Graunke and Phillips fail to disclose the recited feature:

a. "a document stock having counterfeit or encryption resistant features or its own unique identifier". However, the Examiner respectfully disagrees since Graunke discloses this assertion in the abstract, col 3, lines 5-20, lines 53-67, specifically wherein it is stated that a private key to a user's application program such as DVD or CD-ROM with conditional access based on verification (or identification) of the trusted player's integrity and authenticity, col 4, lines 8-61, asymmetric key pair, key compiler, private key or digital signature.

b. "Applicant continues to argue that the Graunke patent does not claim to detect multiple printings". Based upon the foregoing rejection indicated above, it is believed that Graunke discloses this limitation in the abstract, col 3, lines 53-67, col 4, lines 1-61, col 3, lines 53-67, DVD, CD-ROM, specifically wherein it is stated that movie, song, game, etc, as variable document for prevent an unencrypted copy or printing of digital content to be made).

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre Eddy Elisca

Primary Patent Examiner

July 12, 2005